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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,769

01/19/2005

Hans Lichtenstein

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

KOSLOW, CAROL M

ART UNIT

PAPER NUMBER

1755

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/521,769

Applicant(s)

LICHTENSTEIN ET AL.

Examiner

C. Melissa Koslow

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/19/05, 8/17/05, 11/17/05</u> . | 6) <input type="checkbox"/> Other: ____. |

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The duplicate citations in the information disclosure state of 17 November 2005 and the citation of the present application have lines drawn through them.

The EP references cited in the information disclosure statement of 19 January 2005 have been considered with respect to relevancy given in the supplied search report.

The disclosure is objected to because of the following informalities: EP 553,083, discussed on page 1 of the specification, is not directed to moldings. The supplied Derwent abstract for EP 553,083 shows EP 553,083 is directed to installation connecting cordless telephone to subscriber exchange. Appropriate correction is required.

Claims 6 and 9 are objected to because of the following informalities: "Polycarbonate" is misspelled in claim 6. In claim 9, "signage" is plural and thus "a signage" is improper. Appropriate correction is required.

Claims 2 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Claim 2 teaches the white pigment comprises titania, zinc oxide or zinc sulfide, which means the pigment can contain other materials besides the claimed titania, zinc oxide and zinc sulfide. Page 4 of the specification teaches white pigment is titania, zinc oxide or zinc sulfide. The discrepancy between the claimed definition of the pigment and the definition on page 4 needs to be clarified.

Page 5 teaches using the taught moldings for vehicle bodywork, designer furniture, signage or parts thereof or for light systems. There are no methods for producing for vehicle bodywork, designer furniture, signage or parts thereof or for light systems or the method comprising incorporating the taught moldings into vehicle bodywork, designer furniture, signage, light systems or parts thereof disclosed in the specification. The discrepancy between the claimed process and the uses taught on page 5 needs to be clarified.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim is indefinite since there are no actual process steps disclosed for producing vehicle bodywork, designer furniture, signage, light systems or parts thereof. The claimed step of incorporating the molding of claim 1 into these articles does not produce these articles.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06-67612.

The translation of this reference teaches a molding and signs including this molding which must be produced by incorporating the molding in a sign. The taught molding comprises a transparent plastic matrix, such as cast polymethyl methacrylate which has a transmittance in the claimed range, a soluble fluorescent dye, color pigment and 0.01-10 wt% of a white pigment of a mixture of TiO_2 and barium sulfate. The weight ratio of TiO_2 to barium sulfate is greater than 0 wt% to less than 100 wt%. Thus the amount of TiO_2 is in the range of greater than 0 wt% to less than 10 wt%. This range overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Since the taught composition overlaps the claimed composition, one of ordinary skill in the art would expect the taught molding to have a reflectance that overlaps the claimed range, absent any showing to the contrary. The reference suggests the claimed molding and method.

Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,375,864.

This reference teaches a molding comprising a transparent plastic matrix, such as polycarbonate or polyvinyl chloride; a soluble fluorescent dye; a phosphorescent colorant; 0.001-2 wt% of a whitening pigment, such as ZnO , ZnS or TiO_2 and 0.001-20 wt% of a filler, such as calcium carbonate; talc (a magnesium silicate) and china clay (an aluminum silicate). This range overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges

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were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Since the taught composition overlaps the claimed composition, one of ordinary skill in the art would expect the taught molding to have a reflectance that overlaps the claimed range, absent any showing to the contrary. Column 4, lines 33-45 teach incorporating this molding into signs, vehicle bodywork and lighting system. The reference suggests the claimed molding and method.

U.S. patent 4,820,760 is cited as of interest in that it teaches a molding comprising a transparent plastic matrix, a soluble fluorescent dye, barium sulfate and 0.12-0.33 wt% TiO₂. There is no suggestion in the reference to decrease the amount of titania so that it falls within the claimed range.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
January 12, 2007


C. Melissa Koslow
Primary Examiner
Tech. Center 1700